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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,283	02/05/2002	Axel Scherer	CIT,PAU 01	9733
7550	01/23/2004		EXAMINER	
Daniel L. Dawes MYERS, DAWES & ANDRAS LLP 19900 MacArthur Blvd, Ste 1150 Irvine, CA 92612			MCDONALD, RODNEY GLENN	
			ART UNIT	PAPER NUMBER
			1753	

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 10/058,283	Applicant(s) SCHERER ET AL.
Examiner Rodney G. McDonald	Art Unit 1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3 and 5-13 is/are allowed.
- 6) ☒ Claim(s) 1,4,14,15 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other _____

DETAILED ACTION

Election/Restrictions

This application contains claims 16-20 drawn to an invention nonelected with traverse in the Office Action of June 30, 2003. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 14, 15 and 21-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the three dimensional structure formed in the elastomeric material is not discussed in Applicant's specification. Utilizing sputter deposition to form masking layers by means of which the three dimensional structure is photolithographically microfabricated in the elastomeric material is not discussed in Applicant's specification. Directionally etching an elastomeric material in combination with the utilizing of sputter deposition to form masking layers by means of which the three dimensional structure is photolithographically microfabricated in the elastomeric material is not discussed in Applicant's specification.

It is requested that this subject matter either be pointed out in Applicant's specification by page and line number or the subject matter cancelled from the claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 15 and 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14 and 15 are indefinite because "decreasing the surface tension" lacks antecedent basis.

Claim 21, line 2, is indefinite because the phrase "an elastomeric material" is unclear. It is unclear if this is the elastomeric material of claim 1 or another elastomeric material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless—

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Ikeda et al. (U.S. Pat. 6,280,642).

Ikeda et al. teach forming three-dimensional structure on a substrate. (See Fig. 10E) In the process a thin layer of chromium 2 is deposited on a substrate 1 in stripe form by using a sputtering apparatus. (Column 17 lines 19-23, lines 27-31) After formation of the chromium layer a resist layer was coated in the whole surface of the transparent substrate which is an elastomer layer manufactured by Japan Synthetic Rubber Co., Ltd. (Column 18 lines 8-15) The resist layer is then irradiated with ultraviolet radiation. The chromium pattern functioned as a mask to hinder ultraviolet light exposure to area of the resist layer. (Column 18 lines 28-48) (i.e. Photolithography) The areas exposed to ultraviolet layer and not masked by the chromium were removed yielding the patterned layer shown in Fig. 10(E). (Column 18 lines 49-57)

Allowable Subject Matter

Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph set forth in this Office action.

Claims 2, 3 and 5-13 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 2-13 are indicated as being allowable because the prior art of record does not teach Claims 2-13 are indicated as being allowable over the prior art of record because the prior art of record does not teach utilizing silicon dioxide, silicon nitride or silicon as the tension reducing film layer.

Response to Arguments

Applicant's arguments filed January 15, 2004 have been fully considered. Claim 1 has been rejected based upon a newly cited reference to Ikeda et al. Ikeda et al. teach the steps of utilizing a sputtered layer as a mask during a photolithographic process to fabricate three dimensional structures in an elastomeric layer. Claims 1, 14, 15 and 21-25 have been rejected on 35 U.S.C. 112 1st paragraph as discussed above. Claims 14, 15 and 21-25 have been rejected on 35 U.S.C. 112 2nd paragraph as discussed. These rejections were necessitated by Applicant's amendment to the claims. Remaining claims 2-13 have been indicated as being allowable.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney G. McDonald whose telephone number is 571-272-1340. The examiner can normally be reached on M- Th with Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X. Nguyen can be reached on 571-272-1342. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Rodney G. McDonald
Primary Examiner
Art Unit 1753

RM
January 15, 2004